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In re Application of:

RUI, Luciano : DECISION ON PETITION UNDER
U.S. Application No.: 10/584,954 : 37 CFR 1.47(b)
PCT No.: PCT/FR2005/050007 :
International Filing Date: 06 January 2005 :
Priority Date: 07 January 2004 :
Attorney's Docket No.: 292808US6PCT :
For: DEVICE FOR CLEANING ROLLERS :

This decision is issued in response to the "Petition Under 37 CFR 1.47(b)" filed 29 October 2007. Petitioner has filed the required petition fee.

BACKGROUND

On 06 January 2005, applicant filed international application PCT/FR2005/050007. The application claimed a priority date of 07 January 2004, and it designated the United States. On 04 August 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 07 July 2006.

On 05 July 2006, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 29 October 2007, petitioner filed the petition under 37 CFR 1.47(b) considered herein, which seeks acceptance of the application without the signature of the inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1), (2), (3), (4), and (6).

Regarding item (1), petitioner has submitted the required \$200 petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the an inventor has refused to execute the declaration, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.” Here, petitioner has provided statements from Christian Colombier and Nathalie Taramarcaz, with accompanying exhibits, as evidence of the efforts to obtain the signature of the non-signing inventor on the declaration. These materials provide the required firsthand confirmation that a copy of the complete application, with a request for signature on the declaration, was provided to the non-signing inventor, that the inventor has expressly refused to provide the executed declaration, and that the inventor has asserted that further attempts to obtain his signature will be interpreted by the inventor as harassment. These materials are sufficient to confirm that the non-signing inventor has refused to sign the declaration in the present application. Item (2) is satisfied.

Regarding item (3), the petition includes an express statement of the last known addresses of the non-signing inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration executed on behalf of the non-signing inventor by a representative of the 37 CFR 1.47(b) applicant, SAINT-GOBAIN GLASS FRANCE (“Saint-Gobain”). Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has the required proprietary interest based on a “Declaration of Invention” and a “Declaration of Assignment” executed by the inventor; copies of these documents, with English translations, have been included with the petition. These materials confirm that the inventor assigned to Saint-Gobain the French priority application. However, the assignment materials do not expressly refer to the international application (which was filed after these documents were executed), and the present petition does not confirm that the international application includes only subject matter contained in the assigned French priority application.¹ Under such circumstances, a statement is required from a person with firsthand knowledge confirming that the invention disclosed in the international application is the same as that disclosed in the assigned priority application (see MPEP section 409.03(f): “An assignment of an

¹ It is noted that the international application as filed included 14 claims, while the French priority application included only 10.

application and any 'reissue, division, or continuation of said application' does not itself establish an assignment of a continuation-in-part application."). Until the required supplemental materials described above are provided, item (5) is not considered satisfied.

Regarding item (6), the petition includes the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is therefore satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the supplemental materials required to satisfy item (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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